



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,256	11/20/2001	Kingsum Chow	042390.P12722	3252

7590

03/17/2006

Crystal D. Sayles
c/o BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025

EXAMINER

JOO, JOSHUA

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/990,256	CHOW, KINGSUM	
	Examiner	Art Unit	
	Joshua Joo	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/20/01, 6/15/05</u> | 6) <input type="checkbox"/> Other: _____ |

Response to RCE/Amendment filed 1/23/2006

1. Claims 1-26 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- i) As per claims 1 and 20, Applicant's newly amended limitation of "the forwarding server to enter, update, and maintain source and destination electronic mail address in the database" is not supported by the specification of the instant application. The specification on Page 3, lines 3-6, states that a server performs forwarding searches and forwarding action and a database is included in the system for entering, updating, and maintaining... However, the specification does not specifically disclose that a server is performing the actions of entering, updating, and maintaining the email addresses.
- ii) As per claims 7, 10 and 17, the limitation of "if the new electronic address is not found," lacks enablement. The antecedent basis for "the new electronic address" is "*receiving a registration for an electronic mail account of a user to forward emails addressed to the user's old electronic mail address to a new electronic mail address;*". Therefore, the claim states that user registers a new electronic mail address with the system for forwarding of electronic mails. If the new electronic mail address is registered with the

Art Unit: 2154

system, the specification lacks description as to how "the new electronic mail address", which is registered with the system, is not found.

- iii) As per claims 10 and 17, the limitation of "if the new electronic address is not found, dispatch the electronic to the user's old electronic mail address; **and** send an electronic mail message to the sender indicating that the sender's electronic mail message to the user is undeliverable" lacks enablement.

According to Applicant's drawing, Fig. 2, #280, the specification states, "*Sender 120 Receives Email Indicating That Email was Undeliverable if User's 110 Last Known Email Account is no Longer Reachable,*" and on Page 4, lines 14-16, "*the sender-computer 120 will receive the typical messages that describe undeliverable mails, if indeed the electronic mail account is not reachable for some reason*". This is contrary to Applicant's claim of sending an electronic mail message to the sender indicating that the sender's electronic mail message to the user is undeliverable **if** the new electronic mail address is not found. According to the specification, even if the new electronic mail address is not found, if the last the known email account is reachable, then there would be no undeliverable message. The indication of undeliverable message is send based on reach-ability and "if the new electronic mail is not found".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2154

5. Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, US Patent #6,654,779 (Tsuei hereinafter), in view of McDowell et al, US Patent #6,438,583 (McDowell hereinafter) and Polnerow et al, US Patent #5,813,006 (Polnerow hereinafter).

6. As per claim 1, Tsuei teaches substantially the invention as claimed including the system for forwarding electronic mail that is addressed to an old email address to a second email address. Tsuei's teachings comprise of:

a forwarding server, within a data communication network, to receive data from a database, to host forwarding searches, and to perform forwarding actions (Col 9, lines 53-57. Sender ISP sends an address query to the E-mail Address Management system (EAMS hereinafter). Col 10, lines 28-33. Sender ISP receives a new address from the EAMS and forwards the email to the user),

a database, in communication with the forwarding server within the data communication network, to enter, update, and maintain source and destination electronic mail addresses in the database for forwarding; wherein the electronic mail forwarding system is adapted to (Col 6, lines 16-44. EAMS correlates an old email address to a new email address. Maintains a database of old and new addresses),

receive a registration for an electronic mail account of a user to forward emails addressed to the user's old electronic mail address to a new electronic mail address (Col 6, lines 30-44. User registers his/her address change with the EAMS. Col 11, lines 12-16. Registration includes submitting an old email address and a new email address),

receive an electronic mail message from a sender that specifies the user's old electronic mail address as a recipient (Col 9, lines 4-18. Receives message specifying the user's email address.),

Art Unit: 2154

search for the new electronic mail address for the user for forwarding (Col 9, lines 59-64. EAMS searches its database for the new email address); and

forward the electronic mail message to the new electronic mail address, if the new electronic mail address is found (Col 10, lines 24-36. The email is forwarded to the new email address).

7. Tsuei teaches substantial features of the claimed invention including providing different types of authentication processes for using the service to change the user's email address in order to provide security for users (Col 10, lines 48-60). However, Tsuei does not teach that the forwarding server enter, updates, and maintains the database; and sending a confirmation electronic mail with a required password to the user.

8. McDowell teaches a similar system of forwarding electronic mails, wherein a reroute server updates, enters, and maintains the source and destination electronic mail addresses (Col 6, lines 45-57; Col 7, lines 11-33).

9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and McDowell because the teachings of McDowell for a reroute server to update, enter, and maintain the source and destination electronic mail addresses would improve the capability of the system of Tsuei and Polnerow by providing a server capable of both management of email addresses and forwarding of messages which can serve as a gateway for different ISPs (Col 8, lines 23-31).

10. Polnerow teaches of registering to use a service, wherein an electronic mail with a required password is sent to the user (Col 1, lines 46-49).

Art Unit: 2154

11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Tsuei and McDowell with the teachings of Polnerow because the teachings of Polnerow to provide a password in an electronic mail would improve the security of Tsuei and McDowell's system by providing authentication information to the user to log in and access the service.

12. As per claim 2, Tsuei teaches the system of claim 1, wherein the data communication network includes at least one of the Internet and an Intranet (Col 4, lines 36-37. Electronic mail operates in an Internet environment. Col 1, lines 46-54. Electronic mail may involve domains such as .gov, .mil, or .edu).

13. As per claim 7, Tsuei does not teach the system of claim 1, wherein the electronic mail forwarding system is further adapted to forward the electronic mail message from the sender to the user's old electronic mail address, if the new electronic mail address is not found.

14. McDowell teaches of forwarding the electronic mail message to the user's old electronic mail address if the user is not registered (Col 8, lines 23-44).

15. McDowell does not explicitly teach of not finding the new electronic mail address. However, it would have been obvious that the new electronic mail address would not be found if the new electronic mail address is not registered with the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, and Polnerow because the teachings of McDowell to forward electronic mail message to the user's old electronic mail address if a forwarding address is not found would improve the system of Tsuei, McDowell, and Polnerow by allowing users that are

Art Unit: 2154

not registered with the forwarding system or users without forwarding addresses to receive email messages.

16. As per claim 8, Tsuei, McDowell, and Polnerow taught the system of claim 7. Tsuei further teaches wherein the sender receives an electronic mail message indicating that the sender's electronic mail message is undeliverable if the user's old electronic mail address is no longer reachable (Col 10, lines 7-11. Sender ISP notifies the sender via an email that the message could not be delivered to the provided address).

17. Claims 3, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, McDowell, and Polnerow, in view of Quine, US Patent #6,957,248 (Quine hereinafter).

18. As per claim 3, Tsuei does not teach the system of claim 1, wherein the user's electronic email address is disabled after the user registration.

19. Quine teaches the concept of closing an email account (Col 4, lines 45-60; Col 7, lines 54-67).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow and Quine because the teachings of Quine to close an email account would improve the capability of the system of Tsuei, McDowell, and Polnerow by preventing future emails into the account and an disabled account would allow the sender to receive undeliverable messages.

21. As per claim 6, Tsuei does not teach the system of claim 1, wherein the user's new electronic mail address is made unavailable to the sender.

Art Unit: 2154

22. Quine teaches of electronic mail forwarding wherein a user's new electronic mail address is made unavailable to the sender (Col 10, lines 4-21).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow, and Quine because the teachings of Quine to make the user's new email address unavailable to the sender would improve the system of Tsuei, McDowell, and Polnerow by protecting the privacy of the user and preventing the sharing of the user's new email address.

24. As per claim 9, Tsuei does not teach the system of claim 1, wherein the sender receives an electronic mail message from the electronic mail forwarding system informing the sender that the sender's electronic mail message was successfully forwarded.

25. Quine teaches of sending an email to the sender indicating that the email was properly forwarded (Col 9, lines 18-31).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow, and Quine because the teachings of Quine to send an email to the sender indicating that the email was properly forwarded would improve the user friendliness of the system of Tsuei, McDowell, and Polnerow by providing confirmation information, thus the sender does not have to resend emails.

27. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, McDowell, and Polnerow, in view of Decuir, US Patent #6,920,564 (Decuir hereinafter).

Art Unit: 2154

28. As per claim 4, Tsuei teaches of communicating through electronic mail to the user's friends and acquaintances by providing the user's electronic mail address (Col 5, lines 51-60). However, Tsuei does not teach the system, wherein server forwards an electronic mail address of the sender to the user.

29. Decuir teaches the well-known concept of providing the electronic mail address of the sender to the recipient (Col 8, line 66 – Col 9, line 15).

30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow, and Decuir because the teachings of Decuir to provide the electronic mail address of the sender to the recipient would improve the system of Tsuei, McDowell, and Polnerow by providing identification information of the sender and allowing users to reply to the senders.

31. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, McDowell, Polnerow, and Decuir, in view of MacIntosh et al, US Publication #2002/0138581 (MacIntosh hereinafter).

32. As per claim 5, Tsuei does not teach the system of claim 4, wherein the user responds to one of the sender directly or to the sender indirectly through the server.

33. MacIntosh teaches that a user can respond directly and indirectly to the sender through the server by providing an option to mask the user's email address so that sender does not know the user's email address (Paragraph 0093).

34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow and MacIntosh because the

Art Unit: 2154

teachings of MacIntosh to allow the user to respond directly and indirectly through the server would enhance the system of Tsuei, McDowell, and Polnerow by providing greater privacy and protection to the user.

35. Claims 10-12, 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, in view of Polnerow, Decuir, and McDowell.

36. As per claims 10, 17, and 21, Tsuei teaches substantially the invention as claimed including the system for forwarding electronic mail that is addressed to an old email address to a second email address. Tsuei's teachings are implemented as one or more computer application programs, operative to run on a computer apparatus (Col 8, lines 51-54). Tsuei's teachings comprise of:

receive a registration for an electronic mail account of a user to forward emails addressed to the user's old electronic mail address to a new electronic mail address (Col 6, lines 30-44. User registers his/her address change with the EAMS. Col 11, lines 12-16. Registration includes submitting an old email address and a new email address),

receive an electronic mail message from a sender that indicates the user's old electronic mail address as a recipient (Col 9, lines 4-18. Receives the email that specifies the recipient's email address. Col 9, line 18,),

search a database for the new electronic mail address of the user for forwarding (Col 7, lines 31-43; Col 9, lines 39-64. Receives query to search database for the new email address),

if the new electronic mail address is found,

forwarding the electronic mail message to the new electronic mail address (Col 10, lines 24-37. The email is forwarded to the new email address),

if the new electronic mail address is not found,

send an electronic mail message to the sender indicating that the sender's electronic mail message to the user is undeliverable (Col 10, lines 7-11. Sender ISP notifies the sender via an email that the message could not be delivered to the provided address).

37. Tsuei teaches substantial features of the claimed invention. However, Tsuei does not teach of sending a confirmation electronic mail with a required password to the user; providing the electronic mail address of the sender to the user; and if the new electronic mail address is no found, dispatching the electronic mail message to the user's old electronic mail address.

38. Polnerow teaches of registering to use a service, wherein an electronic mail with a required password is sent to the user (Col 1, lines 46-49).

39. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Tsuei with the teachings of Polnerow because the teachings of Polnerow to provide a password in an electronic mail would improve the security of Tsuei's system by providing authentication information for the user to log in and access the service.

40. Decuir teaches the well known concept of providing the electronic mail address of the sender to the recipient (Col 8, line 66 – Col 9, line 15).

41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, and Decuir because the teachings of Decuir to provide the electronic mail address of the sender to the recipient would improve the system of Tsuei and Polnerow by providing identification information of the sender and allowing users to reply to the senders.

Art Unit: 2154

42. McDowell teaches of forwarding the electronic mail message to the user's old electronic mail address if the user is not registered (Col 8, lines 23-44).

43. McDowell does not explicitly teach of not finding the new electronic mail address. However, it would have been obvious that the new electronic mail address would not be found if the new electronic mail address is not registered with the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, Decuir and McDowell because the teachings of McDowell to forward electronic mail message to the user's old electronic mail address if a forwarding address is not found would improve the system of Tsuei, Polnerow, and Decuir by allowing users to receive email messages even if users are not registered users of the service.

44. As per claim 11, Tsuei teaches the system of claim 10, wherein the instructions are provided to a forwarding server of the electronic mail forwarding system to host forwarding searches and to execute forwarding actions (Col 9, lines 59-64. Sender ISP sends an address query to the EAMS. Col 10, lines 28-33. Forwards the email to the user).

45. As per claim 12, Tsuei teaches the system of claim 10, wherein the instructions are provided to enable a database to receive, update, and maintain old and new electronic mail addresses of users for forwarding (Col 6, lines 16-24. EAMS is a database system used to correlate an old email address to a new email address. Col 6, lines 31-44. User registers his/her address change with the EAMS, and the EAMS maintains a database of the old and new addresses).

Art Unit: 2154

46. As per claim 18, Tsuei teaches the system of claims 17, wherein the data communication network includes at least one of the Internet and an Intranet (Col 4, lines 36-37. Electronic mail operates in an internet environment. Col 1, lines 46-54. Electronic mail may involve domains such as .gov, .mil, or .edu).

47. As per claim 19, Tsuei teaches the method of 17, wherein a forwarding server, having circuitry to send and receive data to and from a database, performs forwarding searches and provides forwarding actions (Col 9, lines 53-54. Sender ISP sends an address query to the EAMS. Col 10, lines 28-33. Sender ISP receives a new address from the EAMS and forwards the email to the user. Col 8, line 64-65. A computer system is associated with the sender ISP and the EAMS).

48. As per claim 20, Tsuei teaches the method of entering, updating, and maintaining electronic mail addresses in the database for forwarding (Col 6, lines 16-44). However, Tsuei does not teach that the forwarding server performs the actions entering, updating, and maintaining electronic mail addresses.

49. McDowell teaches a similar system of forwarding electronic mails, wherein a reroute server updates, enters, and maintains the source and destination electronic mail addresses (Col 6, lines 45-57; Col 7, lines 11-33).

50. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, Decuir and McDowell because the teachings of McDowell for a reroute server to update, enter, and maintain the source and destination electronic mail addresses would improve the capability of the system of Tsuei,

Art Unit: 2154

Polnerow, Decuir and McDowell by providing a server capable of both management of email addresses and forwarding of messages which can serve as a gateway for different ISPs (Col 8, lines 23-31).

51. Claims 13, 16, 22, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Polnerow, Decuir, McDowell, in view of Quine.

52. As per claims 13 and 22, Tsuei does not teach the invention, wherein the user's old electronic email address is disabled after the registration.

53. Quine teaches the concept of closing an email account (Col 4, lines 45-60; Col 7, lines 54-67).

54. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow, Decuir, and Quine because the teachings of Quine to close an email account would improve the capability of the system of Tsuei, Polnerow, Decuir, and McDowell by preventing future emails into the account and an disabled account would allow the sender to receive undeliverable messages.

55. As per claims 16 and 26, Tsuei does not teach the invention, wherein the sender is informed that the electronic mail message of the sender has been delivered to the new electronic mail address of the user.

56. Quine teaches of sending an email to the sender indicating that the email was properly forwarded (Col 9, lines 18-30).

Art Unit: 2154

57. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, Decuir, McDowell, and Quine because the teachings of Quine to send an email to the sender indicating that the email was properly forwarded would improve the user friendliness of the system of Tsuei, Polnerow, Decuir, and McDowell by providing confirmation information, thus the sender would not have to resend emails.

58. As per claim 24, Tsuei does not teach the system of claim 17, wherein the user's new electronic mail address is made unavailable to the sender.

59. Quine teaches of electronic mail forwarding wherein a user's new electronic mail address is made unavailable to the sender (Col 10, lines 4-21).

60. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, Decuir, McDowell, and Quine because the teachings of Quine to make the user's new email address unavailable to the sender would improve the system of Tsuei, Polnerow, McDowell, and Quine by protecting the privacy of the user and preventing the sharing of the user's new email address.

61. Claims 14, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Polnerow, Decuir, McDowell, in view of MacIntosh.

62. As per claims 14, 15, and 23, Tsuei does not teach the system, wherein the user responds to one of the sender directly to the sender's electronic mail address or responding indirectly through the forwarding server.

63. MacIntosh teaches that a user can respond directly and indirectly to the sender through the server by providing an option to mask the user's email address so that sender does not know the user's email address (Paragraph 0093).

64. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to provide the user an option to reveal the user's email address to the sender would improve the functionality of Tsuei's system by providing greater privacy and protection to the user.

65. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Polnerow, Decuir, McDowell, in view of Lin et al, US Patent #6,163,802 (Lin hereinafter).

66. As per claim 25, Tsuei does not teach the system of claims 17, wherein the sender receives an electronic mail message from the user informing the sender that the sender's electronic mail message was forwarded.

67. Lin teaches the concept of notifying the sender of a received electronic message (Col 1, lines 42-46).

68. Even though Lin does not disclose a user that receives specifically an email message and sends a response message that is also an email message, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lin's teachings to send an email notification for received email messages because doing so would improve the user friendliness the system of Tsuei, Polnerow, Decuir, and McDowell by providing confirmed

Art Unit: 2154

communication between the sender and recipient, thus allowing the sender to send future emails using the same email address.

Response to Arguments

69. Applicant's arguments with respect to claims 1, 10, and 17 have been considered but are moot in view of the new ground(s) of rejection.

70. Applicant argued that (1) the EAMS does not "receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient." Thus, the EAMS of Tsuei never receives the electronic mail message.

Examiner traverses the arguments:

71. As to point (1), the Sender ISP receives an electronic mail message from a sender that specifies the user's electronic mail account as recipient (Col 9, lines 4-18) and the EAMS is the database that the sender ISP queries and accesses to determine forwarding information (Col 9, lines 53-57; Col 10, lines 28-33).

Conclusion

72. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- i) Reilly, US Patent #6,427,164, discloses of automatically forwarding email with a forwarding address registered with a forwarding server.
- ii) Berkowitz et al, US Publication #2003/0088629, discloses registering old and new email addresses to a database, intercepting emails, and rerouting email from old address to the new email address.

Art Unit: 2154

- iii) Almeda et al, US Publication #2003/0018722, discloses providing old and new email addresses to a forwarding server, receiving an email, and redirecting the email to the client.

73. This action is non-final due to Applicant's filing of RCE.

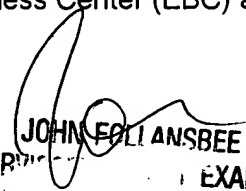
74. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

75. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

76. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on 571 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

77. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 6, 2006
JJ


JOHN FOLLANSBEE
SUPERVISOR, EXAMINER
TECHNOLOGY CENTER 2100